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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,016	11/24/1999	YAKOV KAMEN	ISURFTV11	5713

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EXAMINER	
SRIVASTAVA, VIVEK	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/449,016	KAMEN ET AL.	
	Examiner	Art Unit	
	Vivek Srivastava	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 5 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Deluca (US 5,973,723).

Regarding claim 1, Deluca discloses "*In response to the detect signal, selector 20 deemphasizes the current program by terminating presentation of the undesirable program information and emphasizes an alternate program or by substituting the alternate information. Or more simply, one embodiment of the invention automatically changes the channel when a frame of an undersirable commercial is detected. If a program receiver 10 is a multi-tuner and*

the television has picture in picture capabilities, the selector may cause the undersirable program information to be deemphasized by placing it in a small PIP window, while alternate program information is emphasized by occupying a larger display area" (see col. 3 lines 8 – 13). Deluca teaches deemphasizing presentation of a first commercial, changing the subject matter displayed on the video screen by displaying an alternate program while the deemphasized commercial is displayed in the PIP window thus providing an indication or the television commercial program. It is noted that by terminating presentation by deemphasizing the commercial, the commercial must first be displayed.

Regarding claim 2, Deluca discloses the claimed modifying what is displayed in the window when the segment is over (see col. 3 lines 18 – 29).

Regarding claims 4 and 5, Deluca discloses a PIP window which displays a commercial and thus discloses the claimed thumbnail commercial.

Regarding claim 8, Deluca discloses tuning to another broadcast channel (see col. 3 lines 14 – 18) and thus discloses the claimed "changing the subject matter comprises viewing another regularly received television channel on the video screen".

Claims 11, 14, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Montero (US 6,133,912).

Regarding claim 11, Montero discloses broadcasting a first video program with a segment (see fig. 6, "EYEWITNESS NEWS" in program window 371) and providing additional signal information to be displayed in a window on a video screen while simultaneously

displaying information other than the first video program (see fig. 6) if a viewer changes a program (see col. 21 lines 54 – 59).

Regarding claim 14, Montero discloses the claimed television commercial (see col. 17 lines 20 – 27).

Regarding claim 15, Montero discloses broadcasting a link which is inherently associated with banner 373 which a viewer can click on (see fig. 6).

Regarding claim 16, Montero discloses linking to the Internet which inherently has web pages (see col. 21 lines 15 – 20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deluca (US 5,973,723).

Regarding claims 3 and 6, Deluca fails to disclose the claimed "*wherein said window region is a banner advertising products and/or services*" and "*wherein said window region displays a banner indicative of a product being advertised during said commercial*".

Official Notice is taken it would have been notoriously well known to include a banner as an effective means of advertising which occupies less space on a television screen. Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Deluca to include the claimed banner advertising to provide an effective means of advertising while minimizing the amount of space required.

Claims 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deluca (US 5,973,723) in view of Shoff et al (US 6,240,555).

Regarding claims 7, 9 and 10, Deluca discloses a system which displays alternate programs during a commercial, but fails to disclose the claimed "wherein said changing of said subject matter comprises using said video screen to access the internet", "wherein a link is associated with said window region, said method further comprising invoking said link" and "wherein said link is to a web page".

In analogous art, Shoff teaches "*The viewer can click on or otherwise activate, the icon to enter the interactive mode and display the supplemental content. As an alternative, the supplemental content can be automatically displayed in response to launching the internet browser" (see col. 3 lines 21 – 27). Shoff further teaches "The target resource contains the supplemental content to enhance the television program. The supplemental content might be, for example, questions about the program, games, trivia information on other episodes, advertisements, a listing of products or memorabilia about the program, and so on*". It would have been obvious to modify Deluca to include the claimed limitations for the benefit of enhancing a television program by providing interactive content. Therefore, it would have been obvious to one having ordinary skill

in the art at the time the invention was made to modify Deluca to include the claimed limitation for the benefit of enhancing a television program.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montero (US 6,133,912).

Regarding claims 12 and 13, Montero fails to disclose the claimed wherein the additional signal information to be displayed is included in a portion of a video signal that does not normally contain visual information and wherein said portion of said video signal comprises a retrace interval or blanking interval.

Official Notice is taken it would have been well known transmit data in the VBI to maximize bandwidth efficiency when transmitting data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Montero to include the claimed limitation for the benefit of maximizing bandwidth efficiency.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Srivastava whose telephone number is (571) 272-7304. The examiner can normally be reached on Monday – Friday from 9 am to 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272 – 7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vs
4/29/04

VIVEK SRIVASTAVA
PRIMARY EXAMINER